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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,596	04/25/2006	Bradley Paul Morgan	10444.0090-00000	2514
22852 7590 05/29/2007 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER CHANDRAKUMAR, NIZAL S	
			ART UNIT 1625	PAPER NUMBER
			MAIL DATE 05/29/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/541,596

Applicant(s)

MORGAN ET AL.

Examiner

Nizal S. Chandrakumar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 and 42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-28 and 42 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

This application filed 04/25/2006 is a 371 of PCT/US04/01069 01/14/2004 which claims benefit of 60/440,133 01/14/2003 and claims benefit of 60/440,183 01/14/2003 and claims benefit of 60/476,086 06/04/2003 and claims benefit of 60/476,517 06/05/2003 and claims benefit of 60/501,376 09/08/2003. Claims 29-41 and 43-55 are cancelled. Claims 1-27 and 28 and 42 are before the Examiner and subject to the following Election/Restrictions.

#### ***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

- I. Claim 1-27 (in part) and claim 28 and 29 are, drawn to compounds of the formula I wherein  $R^1 = \text{aryl}$  (i.e.,  $Y = Z = C$ ), classified in various classes and subclasses depending on  $R^2$  group
- II. Claim 1-27 (in part), drawn to compounds of the formula I where in  $X = O$ ,  $Y = C$  and  $Z = N$ , classified in class 546, subclass various depending on  $R^2$  group.
- III. Claim 1-27 (in part), drawn to compounds of the formula I where in  $X = S$ ,  $Y = C$  and  $Z = N$ , classified in class 546, subclass various depending on  $R^2$  group.

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- IV. Claim 1-27 (in part), drawn to compounds of the formula I where in  $X = O$ ,  $Y = N$  and  $Z = C$ , classified in class 546, subclass various depending on  $R^2$  group.
- V. Claim 1 1-27 (in part), drawn to compounds of the formula I where in  $X = S$ ,  $Y = N$  and  $Z = C$ , classified in class 546, subclass various depending on  $R^2$  group.
- VI. Claims 28 (in part) are, drawn to pharmaceutical formulations containing compounds of the formula I wherein  $R^1 = \text{aryl}$  (i.e.,  $Y = Z = C$ ), classified in class 514, subclass various.
- VII. Claims 28 (in part) are, drawn to pharmaceutical formulations containing compounds of the formula I where in  $X = O$ ,  $Y = C$  and  $Z = N$ , classified in class 514, subclass various.
- VIII. Claims 28 (in part), drawn to pharmaceutical formulations containing compounds of the formula I where in  $X = S$ ,  $Y = C$  and  $Z = N$ , classified in class 514, subclass various.
- IX. Claims 28 (in part), drawn to pharmaceutical formulations containing compounds of the formula I where in  $X = O$   $Y = N$  and  $Z = C$ , classified in class 514, subclass various.
- X. Claims 28 (in part), drawn to pharmaceutical formulations containing compounds of the formula I where in  $X = S$   $Y = N$  and  $Z = C$ , classified in class 514, subclass various.

- XI. Claim 42 is, drawn to pharmaceutical methods of use of compounds of the formula I wherein  $R^1 = \text{aryl}$  (i.e.,  $Y = Z = C$ ), classified in class 514, subclass various.
- XII. Claim 42 is, drawn to pharmaceutical methods of use of compounds of the formula I where in  $X = O$ ,  $Y = C$  and  $Z = N$ , classified in class 514, subclass various.
- XIII. Claim 42 is, drawn to pharmaceutical methods of use of compounds of the formula I where in  $X = S$ ,  $Y = C$  and  $Z = N$ , classified in class 514, subclass various.
- XIV. Claim 42 is, drawn to pharmaceutical methods of use of compounds of the formula I where in  $X = O$   $Y = N$  and  $Z = C$ , classified in class 514, subclass various.
- XV. Claim 42 is, drawn to pharmaceutical methods of use of compounds of the formula I where in  $X = S$   $Y = N$  and  $Z = C$ , classified in class 514, subclass various.

Claims 3-5 are not considered because they improperly depend on claim 2.

The inventions listed as Groups I-XV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the common

technical feature in all groups is aryl urea. This element cannot be a special technical feature under PCT Rule 13.2 because the element is shown in the prior art, see Dumas et al. US 20020165394, entire application.

Claims 1-27 are generic to a plurality of disclosed patentably distinct compounds with respect to R<sup>2</sup> comprising optionally substituted phenyl, optionally substituted naphthyl, optionally substituted pyrrolyl, optionally substituted, thiazolyl, optionally substituted isooxazolyl, optionally substituted pyrazolyl, optionally substituted pyridinyl, optionally substituted pyrazinyl, optionally substituted pyrimidinyl, or optionally substituted pyridazinyl. Applicant is required to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction were not required; because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

5. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nizal S. Chandrakumar whose telephone number is 517-272-6202. The examiner can normally be reached on 8.30 am – 5 pm Monday-Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie can be reached on 571-272-0670 or Primary Examiner D. Margaret Seaman can be reached at 571-272-0694. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Nizal S. Chandrakumar



D. MARGARET SEAMAN  
PRIMARY EXAMINER